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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,258	03/25/2004	Klaus Fahrlander	885_001	6909
25191	7590	03/17/2005	EXAMINER	
BURR & BROWN PO BOX 7068 SYRACUSE, NY 13261-7068			LEDYNH, BOT L	
			ART UNIT	PAPER NUMBER
			2862	

DATE MAILED: 03/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/809,258

Applicant(s)

FAHRLANDER ET AL.

Examiner

Bot LeDynch

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2005 and 28 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6 and 10-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13-19 and 23-29 is/are allowed.
- 6) ☒ Claim(s) 2-6, 10, 11 and 20-22 is/are rejected.
- 7) ☒ Claim(s) 12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.



Bot LeDynch
Primary Examiner

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 2-4, 6, 10, and 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by White et al. (5955881). White et al. discloses the same invention as claimed: A path and/or position measuring device comprising a magnet (88, 90, etc.) and an analog Hall sensor (240, 40, 96, 108) detecting the magnetic field intensity, the magnet and/or the sensor co-operating with a movable element (74, 76), the magnet being formed in such a way that the magnetic field intensity varies along an axis of the magnet, and it being possible for a relative movement between the sensor and the magnet substantially in the direction of this of the magnet to be brought about by means of the movable element in such a way that the path and/or the position of the movable element can be determined on the basis of the magnetic field intensity detected by the sensor, characterized in that the magnet is fastened to the movable element, ram 92, push rod (76, 74); magnet being fitted or integrated (at 78, 80, etc.) into movable element (74 or 76). As to the limitation "a housing having securing means for securing a printed circuit board" (claim 10), White et al. inherently possesses this limitation. First, house (or housing) is defined as "any place where something is thought of as living, resting, etc." (see Webster's New World Dictionary, 3rd College Edition). Second, White et al.'s circuit board (col.4, lines 36-46) inherently has to be secured to a housing; it

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cannot be suspended in the air to support detector 40 without being secured to a housing.

An alternative 103 rejection follows.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4, 6, 10-11, 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (5955881). White et al discloses substantially the same invention as claimed, except for the limitations "a housing having securing means for securing a printed circuit board" and "plug-in receptacle for a connector. It is well known printed circuit board has to be secured to a housing (by a securing means) in order for the printed circuit board (PCB) to be stable and protected; for example, PCBs are secured onto a chassis, box, slot, guide, etc. It is also well known and routine that the housing has plug-in receptacles (or other sockets) for a connector for establishing an electrical connection to a PCB. It would have been obvious to one of skill in the art to secured White et al's circuit board to a housing (by a securing means) in order to provide stability and protection to the circuit board and the detector 40. This also helps "detector 40 remain[s] substantially stationary centrally within the channel" (col. 4, lines 35-36). And it would have been obvious to one of skill in the art to install a plug-in

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receptacle (or any types of sockets) for a connector for establishing power to the circuit board.

Claims 5 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al. (5955881) in view of Rountos et al. (5850142). White et al. (5955881) discloses substantially the same invention as claimed except for the magnet being polymer bonded magnetic particles produced by injection molding. Rountos et al. discloses that magnets made of polymer bonded magnetic particles minimize cross talk. It would have been obvious to one of skill in the art to modify White et al. by using the magnet made of polymer bonded magnetic particles in order to minimize cross talk.

As to the method limitations "injection molding" (claim 5) and "molded into" (claim 22), it is the Examiner's opinion that such a method step in a product claim, "which product is not patentably distinguished from the prior art, cannot impart patentability to the old product." *In re Dilnot*, 133 USPQ 289,292 (CCPA 1962), citing *In re Moeller*, 28 CCPA 932, 117 F.2d 565, 48 USPQ 542 ; *In re Lifton*, 38 CCPA 1119, 189 F.2d 261, 89 USPQ 641 ; *In re Shortell*, 36 CCPA 1013, 173 F.2d 993, 81 USPQ 359 . "Even though product - by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product - by - process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe* , 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). See MPEP 2113.

"[T]he lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith." *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). See also MPEP 2113.

The end product of Applicant's device and that of prior art's are the same (i.e., molded magnet having two-component parts in the movable element) although made by different methods. Thus, the added method limitation imparts no patentability to Applicant's claimed product.

Allowable Subject Matter

Claims 13-19 and 23-29 are allowed.

Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bot LeDinh whose telephone number is 5712722231. The examiner can normally be reached on Maxiflex.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Lefkowitz can be reached on 5712722180. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BL/ 2005


Bot LeDinh, J.D., Ph.D., D.A.
Primary Examiner